



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/597,875

05/12/2008

Garret J. Buban

YAMAP1017US

3829

51921

7590

06/08/2011

MARK D. SARALINO (PAN)
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
19TH FLOOR
CLEVELAND, OH 44115

EXAMINER

DINH, TAN X

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

06/08/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,875	Applicant(s) BUBAN ET AL.	
	Examiner TAN X. DINH	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

1) This application is a 371 of PCT/JP2005/008823, filed on 5/09/2005.

2) Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 is drawn to a “program” per se as recited in the preamble and as such are non-statutory subject matter. See MPEP § 2106.IV.B.1.a. Claims to processes that do nothing more than install a program in a computer or concepts are non-statutory. If the “acts” of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. *SCHRADER*, 22 F.3d at 294-95, 30 USPQ2d at 1458-59. Thus, a process consisting solely of mathematical operations without some claimed practical application or does not manipulate appropriate subject matter are not constitute a statutory process. In this case, the claims merely recite a program for controlling the writing on write-once optical disc, which simply manipulates abstract ideas without some claimed practical application.

3) This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

4) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy

Art Unit: 2627

reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees.

A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5) Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 10/597,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim(s) 1-12 of the instant application are anticipated by claim(s) 1-8 of copending application 10/597,863 in that claim(s) 1-8 of the copending application contains all the limitation of claim(s) 1-12 of instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

7) (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8) Claims *1,5-10,11 and 12* rejected under 35 U.S.C. 102(b) as being anticipated by **TAKANAO et al (5,448,728)**.

TAKANAO et al discloses a method for instructing a to write data on a write-once disc, as claimed in claim 1, comprising:

(a) receiving a write request which specifies at least data for a file to be written (column 1, lines 41-46 and Figure.4, steps S2 and S3);

(b) instructing the drive apparatus to read a file entry of a metadata file which contains metadata for managing the file from a location of the write-once disc, so as to obtain the file entry of the metadata file (Fig.7, steps S11 and S12);

(c) obtaining track information indicating a location of each of the plurality of tracks (the disc management area contains information of plural tracks);

(d) determining a track from the plurality of tracks in which metadata is to be written next, based on the file entry of the metadata file and the track information (figure 4 and column 6, lines 17-43);

(e) instructing the drive apparatus to read the metadata from a location of the write-once disc, so as to obtain the metadata (Figure 4 and column 6, lines 44-50);

(f) obtaining a next writable address indicating a location at which data is to be written next within a track other than the track determined in the step (d), the track being selected from the plurality of tracks (Fig.4, steps S5 to S9);

(g) updating the metadata to reflect the writing of the data specified by the write request (column 6, lines 51-63);

(h) instructing the drive apparatus to write the data specified by the write request to a location indicated by the next writable address in the write-once disc (Fig.4, steps S5-S9); and

(i) instructing the drive apparatus to write at least a part of the updated metadata to the location from which the metadata is read in the step (e) in the write-once disc (column 6, lines 44-63. See also column 9, lines 16-62 and column 10, lines 36-67).

Claims 5-8 and 11 are rejected with the same reasons set forth in claim 1 above.

As to claims 9 and 10, TAKANAO et al shows allocating at least first and second tracks in response to the allocation instruction (figure 7, steps S11 and S12).

9) Claims 2-4 would be allowable if rewritten to overcome the rejection(s) under nonstatutory obviousness-type double patenting, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that in amending in response to a rejection of claims (if the rejection involves with any applicable arts), the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objection made. Applicant must also show how the amendments avoid such references and objections. See 37 CFR § 1.111(c).

Form PTO-892 is attached herein.

11) Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAN Xuan DINH whose telephone number is 571-272-7586. The examiner can normally be reached on MONDAY to FRIDAY from 9:00AM to 5:00PM.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status

information for published applications may be obtained from either **Private PAIR** or **Public PAIR**.

Status information for unpublished applications is available through **Private PAIR** only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal>. Should you have questions on access to the **Private PAIR** system, contact the **Electronic Business Center (EBC)** at **866-217-9197** (toll-free).

/TAN X DINH/
Primary Examiner, Art Unit 2627
June 2, 2011